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Filing date: **08/14/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049926
Party	Defendant Cloudstreet, Inc. dba Roxbury Entertainment
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Submission	Motion to Dismiss - Rule 12(b)
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Date	08/14/2010
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>CLOUDSTREET, INC. DBA ROXBURY ENTERTAINMENT,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No. 92049926</p> <p>Registration Nos. 3189543; 3194255; 3291736</p> <p>Mark: ROUTE 66</p> <p>Issued: December 26, 2006; January 2, 2007; September 11, 2007</p>
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**REGISTRANT'S MOTION TO DISMISS
AMENDED CONSOLIDATED PETITION TO CANCEL**

Registrant, Cloudstreet, Inc. d/b/a Roxbury Entertainment ("Registrant"), by its attorneys, hereby moves the Board, pursuant to Fed. R. Civ. P. 12(b)(6), to enter an order dismissing with prejudice Petitioner's claims for cancellation of Registrant's Class 9 registration for DVD's and Videocassettes on the basis that Petitioner by reference to its own judicial admission in this proceeding cannot allege or prove the elements of fraudulent procurement.

STANDARDS

In determining whether a litigant before the Board has stated a claim upon which relief can be granted, the Board "must assume that the facts alleged in the

petition are true.” *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 566, 189 U.S.P.Q. 420, 422 (CCPA 1976) (petition for cancellation of a registered mark). “To state a claim, the complaint must allege facts ‘plausibly suggesting (not merely consistent with)’ a showing of entitlement to relief,” and “[t]he factual allegations must be enough to raise a right to relief above the speculative level.” *Cary v. United States*, 552 F.3d 1373, 1376 (Fed. Cir. 2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556-57 (2007)), *cert. denied*, 129 S. Ct. 2878 (2009). Dismissal is appropriate if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations. See *Young v. AGB Corp.*, 152 F.3d 1377, 1379 (Fed. Cir. 1998).

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009). “A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof,” and fraud must be proven “to the hilt” without any room for speculation, inference, or surmise – “any doubt must be resolved against the charging party.” *Id.* Indeed, a trademark registration is obtained fraudulently under the Lanham Act “only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the [USPTO].” *Id.* at 1245 (emphasis added).

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ARGUMENT

Petitioner's counsel admitted in its original Petition for Cancellation that Registrant had begun to use its Mark in commerce in connection with the sale of DVD's as early as 2005, Petitioner even attached as part of an exhibit to the original Petition a copy of a Specimen of Use filed by Registrant in connection with that application to prove that Registrant had commenced its first use of the Mark on DVD's in 2005.

"On information and belief, Registrant (including its predecessors-in-interest) did not use the Asserted Mark in commerce on DVDs until 2005, at least nine years after Registrant's claimed date of first use. The specimen of use submitted to the Trademark Office by Registrant in support of the Amendment to Allege Use in the application underlying the DVD/Videocassette Registration corroborates this belief since it depicts Registrant's DVD box artwork sleeve bearing a copyright notice dated 2005 and claiming to be the "First Ever DVD Release." See Amendment to Alleged Use, filed July 14, 2006, attached as Exhibit 1."

In Petitioner's Amended Consolidated Petition, filed on June 14, 2010, however, Petitioner falsely and fraudulently alleged, in direct contravention of Petitioner's earlier judicial admission, that Registrant's first use of the Mark on DVD's did not commence until 2007, and therefore Registrant had committed fraud on the PTO in connection with its Statement of Use:

When Registrant made this representation on July 14, 2006, Registrant knew that it had not used the ROUTE 66 mark on or in connection with DVDs. Indeed, the distributor of Registrant's DVDs, Infinity Entertainment Group, testified at a deposition in the Lawsuit that its involvement in distributing DVDs for sale in interstate commerce did not begin until 2007. In addition, the president and founder of the marketing

company that Registrant employs, Greenleaf & Associates, admitted that its involvement in the sales of Registrant's DVDs did not begin until the summer of 2007. Moreover, Greenleaf & Associates created a press release in October 2007 to promote the DVD release for Registrant.

Petitioner's earlier judicial admission was a correct statement of the facts, however, and its current position is patently false and intentionally misleading. Under these circumstances, Petitioner cannot begin to allege and prove requisite elements of fraudulent procurement "to the hilt" or otherwise, as required by *Bose*, and its fraud claim with respect to Registrant's Class 9 DVD/Videocassette registration must be dismissed with prejudice.

Respectfully submitted,

/s/

Paul D. Supnik
9601 Wilshire Boulevard, Suite 1012
Beverly Hills, California 90210-5210
Telephone: (310) 859-0100
Facsimile: (310) 388-5645

Dated: August 13, 2010

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing **REGISTRANT'S MOTION TO DISMISS AMENDED CONSOLIDATED PETITION TO CANCEL** was served by first class mail, postage prepaid, on this 13TH day of August 2010, upon counsel for Petitioner:

Floyd A. Mandell, Esq.
Lisa K. Shebar, Esq.
Cathay Y. N. Smith, Esq.
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, IL 60661-3693

/s/
PAUL D. SUPNIK

Exhibit 1

Trademark/Service Mark Amendment to Allege Use (15 U.S.C. Section 1051(c))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78977114
LAW OFFICE ASSIGNED	LAW OFFICE 114
NOTICE OF ALLOWANCE	NO
EXTENSION OF USE	NO
REQUEST TO DIVIDE	NO
MARK SECTION	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ROUTE 66
OWNER SECTION (no change)	
ATTORNEY SECTION (no change)	
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	009
GOODS AND/OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	02/28/1995
FIRST USE IN COMMERCE DATE	02/28/1995
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT4\IMAGEOUT4\789\771\78977114.xml\AAU0002.JPG
SPECIMEN DESCRIPTION	copy of DVD insert
PAYMENT SECTION	
NUMBER OF CLASSES	1
SUBTOTAL AMOUNT	100
TOTAL AMOUNT	100
SIGNATURE SECTION	
SIGNATURE	/KIRK HALLAM/
SIGNATORY NAME	Kirk Hallam
SIGNATORY DATE	07/14/2006
SIGNATORY POSITION	President
FILING INFORMATION	
SUBMIT DATE	Fri Jul 14 19:34:30 EDT 2006
TEAS STAMP	USPTO/AAU-69.234.151.78-2 0060714193430694319-78977 114-3325cb4df7f261d89f5f1 e5cafbbb6e664-CC-748-2006 0712204215357385

**Trademark/Service Mark Amendment to Allege Use
(15 U.S.C. Section 1051(c))**

To the Commissioner for Trademarks:

MARK: ROUTE 66
SERIAL NUMBER: 78977114

The applicant, CLOUDSTREET, INC. dba Roxbury Entertainment, having an address of 201 Wilshire Boulevard, Second Floor, Santa Monica, California United States 90401, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class: 009, the applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 02/28/1995, and first used in commerce at least as early as 02/28/1995, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) copy of DVD insert.

Specimen-1

The applicant hereby appoints Paul D. Supnik to submit this Trademark/Service Mark Amendment to Allege Use on behalf of the applicant. The attorney docket/reference number is 2226-11.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /KIRK HALLAM/ Date Signed: 07/14/2006
Signatory's Name: Kirk Hallam
Signatory's Position: President

RAM Sale Number: 748
RAM Accounting Date: 07/17/2006

Serial Number: 78977114
Internet Transmission Date: Fri Jul 14 19:34:30 EDT 2006
TEAS Stamp: USPTO/AAU-69.234.151.78-2006071419343069
4319-78977114-3325cb4df7f261d89f5f1e5caf
bbb6e664-CC-748-20060712204215357385

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BEST OF route 66

Route 66 is one of the most unique television series in American History. An edgy adventure series that functioned as an anthology of downbeat character studies and psychological dramas, its 1960 premiere launched two young drifters in a Corvette on an existential odyssey in which they encountered a myriad of loners, dreamers and outcasts in the small towns and big cities along U.S. Highway 66 and beyond.



THIS DVD IS A RE-MASTERED
OF THE ORIGINAL
TELEVISION SERIES
FROM 1960-1966
THIS DVD EDITION
HAS BEEN RE-MASTERED
FROM THE BEST AVAILABLE
MATERIAL

QUEST STARS INCLUDE

- | | |
|-----------------|---------------------|
| Robert Redford | • Robert Duvall |
| James Caan | • Alan Alda |
| Stefanie Powers | • Suzanne Pleshette |
| Boris Karloff | • Peter Lorre |
| Walter Matthau | • Martin Sheen |
| Leslie Nielsen | • Ronny Howard |

SPECIAL FEATURES



1 of the Best Original Episodes
Originally Re-Mastered for the First Time

FOX VIDEO ENTERTAINMENT COPYRIGHT © 2005

BEST OF
route 66

11 ORIGINAL TELEVISION EPISODES

DVD

FIRST EVER DVD RELEASE

11 ORIGINAL TELEVISION EPISODES

BEST OF route 66



BEST OF route 66



Route 66 is one of the most unique television dramas in American History. An edgy adventure series that functioned as an anthology of downbeat character studies and psychological dramas. Its 1960 premiere launched two young drifters in a Corvette on an existential odyssey in which they encountered a myriad of loners, dreamers and outcasts in the small towns and big cities along U.S. Highway 66 and beyond.



ROUTE 66 IS PRESENTED
IN THE ORIGINAL
TELEVISION EDITION
AS IT WAS
THIS NEW SERIES
UNRAVELS THE CHARTERED
FROM THE JUNE 1960

GUEST STARS INCLUDE

- | | |
|-----------------|---------------------|
| Robert Redford | • Robert Duvall |
| James Caan | • Alan Alda |
| Stefanie Powers | • Suzanne Pleshette |
| Boris Karloff | • Peter Lorre |
| Walter Matthau | • Martin Sheen |
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SPECIAL FEATURES



1 of the Best Original Episodes
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REG-1189543 ISBN 1-89977-114 (DVDs and videocassettes)

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11 ORIGINAL TELEVISION EPISODES

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